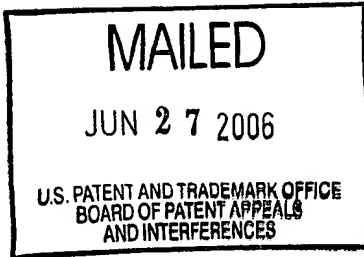


UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES MICHAEL FITZPATRICK

Application 09/730,592

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on June 19, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

An examination of the Image File Wrapper (IFW) reveals that an Appeal Brief was filed on June 16, 2005.

37 CFR § 41.37(c)(1)(v) reads as follows:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by

a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

. . . .

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The “Summary of claimed subject matter” appearing on pages 1 and 2 of the Appeal Brief filed June 16, 2005 is deficient because it does not map the claimed invention to all of the independent claims. Correction is required.

In addition, Information Disclosure Statements (IDSs) were filed on April 25, 2003 and September 30, 2005. It is not apparent from the record whether the examiner considered the statements submitted or notified appellant of why his submissions did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98. A communication notifying appellant of the Primary Examiner’s decision is required.

Finally, an Examiner’s Answer was mailed on January 17, 2006 in response to the Appeal Brief filed June 16, 2005. According to the Answer, “[t]he

statement of the status of claims contained in the brief [filed June 16, 2005]¹ is correct.”

The “Grounds of Rejection to be Reviewed on Appeal” are listed as follows:

1. Claims 40, 44 and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Reuhl et al. (U.S.PAT. 5873069A) [page 4];

2. Claims 1, 2, 5, 14, 15, 16, 24, 25, 28, 50, 51, 53, 54 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel, Jr. et al. (U.S.PAT. 4972504A), Shimoda et al. (U.S.PAT. 4855908A) and Handley (U.S.PAT. 5349648A) [page 5];

3. Claims 3 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel, Jr. et al., Shimoda et al. and Handley as applied to claims 1 and 24 above, and further in view of Riordan et al. (U.S.PAT. 6078891 A) [page 7];

4. Claims 6, 8, 17, 29, 31, 34, 35, 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel, Jr. et al., Shimoda et al. and Handley as applied to claim 5 above, and further in view of Reuhl et al. (U.S.PAT. 5873069 A) [page 8];

5. Claims 9, 10, 11, 12, 13, 18, 19, 20, 21, 22, 23, 32, 33, 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel, Jr. et al., Shimoda et al. and Handley as applied to claims 8, 31, and 37 above, and further in view of Riordan et al. [page 9];

6. Claims 4 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel, Jr. et al., Shimoda et al. and Handley as applied to claims 2 and 25 above, and further in view of Negin et al., An Iris Biometric System for Public and Personal Use, February 2000, IEEE # 0018-9162/00 [page 11];

7. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reuhl et al. and Riordan et al. as applied to claim 41 above, and further in view of Negin et al., An Iris Biometric System for Public and Personal Use, February 2000, IEEE # 0018-9162/00 [page 12]; and

8. Claims 41, 42, 45, 46, 47, 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reuhl et al. in view of Riordan et al. [page 12].

¹ “Claims 1-55 are pending, rejected, and under appeal” [page 1 under the heading 37 CFR 41.37(c)(1)(iii) Status of Claims].

It should be noted that the Final Rejection mailed November 4, 2004 and the Examiner's Answer do not appear to discuss the rejection of claims 7, 30 and 40. Appropriate correction is required.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) for notification to appellants to submit a substitute Appeal Brief which corrects the "Summary of claimed subject matter";
- 2) for consideration of the IDSs filed April 25, 2003 and September 30, 2005 and appropriate notification to appellant regarding the Primary Examiner's decision; and
- 3) for a determination regarding the status of claims 7, 30 and 40; and
- 4) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

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